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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/728,879	12/08/2003	Eugene M. Lee	113708.127US2	9649
23400	7590	07/26/2006	EXAMINER	
POSZ LAW GROUP, PLC 12040 SOUTH LAKES DRIVE SUITE 101 RESTON, VA 20191			DARNO, PATRICK A	
			ART UNIT	PAPER NUMBER
			2163	

DATE MAILED: 07/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/728,879

Applicant(s)

LEE, EUGENE M.

Examiner

Patrick A. Darno

Art Unit

2163

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 07242006.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

1. Claims 1-31 are pending in this office action.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 14-22 are rejected on the grounds of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-5 of U.S. Patent No. 6,662,178 issued to Eugene M. Lee. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of U.S. Patent Number 6,662,178 clearly anticipate the claims set forth in the instant application.

In order to clarify the given rejection, independent claim 1 for U.S. Patent Number 6,662,178 and independent claim 14 from Application Number 10/728,879 have been reproduced below. It is clearly seen that each limitation of Claim 14 from

Application Number 10/728,879 has been anticipated by independent claim 1 of U.S.

Patent Number 6,662,178.

U.S. Patent Number 6,662,178	Application Number 10/728,879
A method of utilizing an intellectual property thesaurus, the method comprising:	A method of utilizing an intellectual property thesaurus, the method comprising:
(a) designating a field of search based on selection of at least one of a plurality of classifications of an intellectual property classification system;	(a) designating a field of search based on selection of at least one of a plurality of classifications of an intellectual property classification system;
(b) generating a list of words found in intellectual property information classified in the field of search designated in said designating step (a);	(b) generating a list of words found in intellectual property information classified in the field of search designated in said designating step (a);
(c) entering search criteria utilizing keywords;	(c) entering search criteria utilizing keywords; <b>and</b>
(d) determining searchable elements related to keywords in the search criteria based on the list of words generated in said generating step (b); wherein said generating step (b) further comprises the step, of determining a frequency of occurrence of each listed word found in the intellectual property information associated with the field of search;	(d) determining searchable elements related to keywords in the search criteria based on the list of words generated in said generating step (b).
(e) displaying, in the form of a word-frequency list, the list of words found in the	

intellectual property information classified in the field of search, wherein each listed word is associated with a corresponding frequency of occurrence of the listed word; wherein said displaying step (e) comprises simultaneous display of the search criteria during operation of said entering step (c) and the display of the word-frequency list.	
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Claims 15-17 are rejected under grounds of nonstatutory obviousness-type double patenting as being unpatentable over the remaining portion of independent claim 1 of U.S. Patent Number 6,662,178 reproduced above, which clearly anticipates claims 15-17.

Claims 18-19 are rejected under grounds of nonstatutory obviousness-type double patenting as being unpatentable over independent claim 2 of U.S. Patent Number 6,662,178, which clearly anticipates claims 18-19.

Claim 20 is rejected under grounds of nonstatutory obviousness-type double patenting as being unpatentable over dependent claim 3 of U.S. Patent Number 6,662,178, which clearly anticipates claim 20.

Claim 21 is rejected under grounds of nonstatutory obviousness-type double patenting as being unpatentable over dependent claim 4 of U.S. Patent Number 6,662,178, which clearly anticipates claim 21.

Claim 22 is rejected under grounds of nonstatutory obviousness-type double patenting as being unpatentable over independent claim 5 of U.S. Patent Number 6,662,178, which clearly anticipates claim 22.

3. Claims 23-31 are rejected on the grounds of nonstatutory obviousness-type double patenting as being unpatentable over claims 6-11 of U.S. Patent Number 6,662,178 issued to Eugene M. Lee (hereinafter "Lee") in view of U.S. Patent Application Publication Number 2004/0230574 issued to Alexander N. Kravets (hereinafter "Kravets").

Patent Number 6,662,178	Application Number 10/728,879
In a search system for use in searching for intellectual property information, the improvement comprising an article of manufacture having stored thereon an executable program operative to effectuate searching for intellectual property information in connection with the search system, wherein the executable program is executed to, perform the steps of:	In a search system for use in searching for intellectual property information, the improvement comprising an article of manufacture having stored thereon an executable program operative to effectuate searching for intellectual property information in connection with the search system, wherein the executable program is executed to perform the steps of:
(a) designating a source grouping of intellectual property information;	(a) designating a source grouping comprising <b>at least one document having</b> intellectual property information;
(b) generating a list of words found in intellectual property information within source grouping designated in said designating step (a);	(b) generating a list of words found in <b>the at least one document in the</b> intellectual property information within the source grouping designated in said designating

	<b>step (a); and providing at least a portion of the elements in the list for later use as search criteria.</b>
(c) formulating search criteria utilizing input keywords;	
(d) determining searchable elements related to the input keywords in the search criteria based on the list of words generated in said generating step (b); wherein said determining step (d) comprises: determining searchable elements related to select keywords in the search criteria by locating words on the list generated in said generating step (b) that are synonyms of select keywords in the search criteria; and wherein said formulating step (c) automatically adds to the search criteria the synonyms determined in said determining step (d) search criteria utilizing input keywords.	

It is clear to see that only minor, obvious differences occur between the independent claims of Patent Number 6,662,178 and Application Number 10/728,879. The Examiner asserts that the two claims above actually represent the same invention.

Specifically, independent claim 6 of Patent Number 6,662,178 discloses all the elements of independent claim 23 of Application Number 10/728,879 except for the

following limitation: "providing at least a portion of the elements in the list for later use as search criteria".

However, Kravets discloses providing at least a portion of the elements in the list for later use as search criteria (Kravets: paragraph [0044]; The reference clearly shows the providing of at least a 'portion' of a word in order to suggest a search term to a user for a later search. These suggested search terms must be stored on some form of list in memory.). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Lee with the teachings of Kravets noted above. The skilled artisan would have been motivated to improve the teachings of Lee per the above such that the search terms that are provided to the user would be terms that would likely produce the best search results (Kravets: paragraph [0044], lines 11-15).

Claims 24-25, and 29 are rejected under grounds of nonstatutory obviousness-type double patenting as being unpatentable over the remaining portion of independent claim 6 of U.S. Patent Number 6,662,178 reproduced above.

Claim 26 is rejected under grounds of nonstatutory obviousness-type double patenting as being unpatentable over dependent claim 7 of U.S. Patent Number 6,662,178.

Claim 27 is rejected under grounds of nonstatutory obviousness-type double patenting as being unpatentable over dependent claim 8 of U.S. Patent Number 6,662,178.



Claim 28 is rejected under grounds of nonstatutory obviousness-type double patenting as being unpatentable over dependent claim 9 of U.S. Patent Number 6,662,178.

Claim 30 is rejected under grounds of nonstatutory obviousness-type double patenting as being unpatentable over dependent claim 10 of U.S. Patent Number 6,662,178.

Claim 31 is rejected under grounds of nonstatutory obviousness-type double patenting as being unpatentable over dependent claim 11 of U.S. Patent Number 6,662,178.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-13 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent Number 5,991,751 issued to Kevin G. Rivette et al. (hereinafter “Rivette”).

**Claim 1:**

Rivette discloses a method of developing an element list for intellectual property information, the method comprising the steps of

designating a source grouping containing documents having intellectual property information (Rivette: column 11, lines 40-44 and column 19, lines 13-28 and Fig. 8, 5804); and

generating a list of elements found in the documents in the source intellectual property information (Rivette: column 26, lines 34-36 and Figs. 12B-12M; The first reference clearly shows searching a group of patent documents (intellectual property). More specifically the reference shows returning and displaying search results after searching a group of patent documents. Surely returning and displaying search results is “generating a list of elements found” in a group of documents.); and

providing at least a portion of the elements in the list as candidate search criteria for later use in searching (Rivette: column 26, lines 34-46; Note that the historical information (portion of elements in the list) is provided to a user in order help restrict a further search.).

**Claim 2:**

Rivette discloses all the elements of claim 1, as noted above, and Rivette further discloses the step of selecting at least a portion of the elements as search criteria (Rivette: column 26, lines 47-55), and searching a plurality of documents including the documents in the source grouping based on the search criteria (Rivette: column 11, lines 40-44).

**Claim 3:**

Rivette discloses all the elements of claim 2, as noted above, and Rivette further discloses wherein the source grouping includes documents logically grouped together in a folder for storage in a memory unit (Rivette: Fig. 58, 5804 & 5808).

**Claim 4:**

Rivette discloses all the elements of claim 2, as noted above, and Rivette further discloses wherein the source grouping includes documents being commonly assigned to the same entity (Rivette: Column 21, lines 17-28 and Fig. 6, 628).

**Claim 5:**

Rivette discloses all the elements of claim 2, as noted above, and Rivette further discloses wherein the source grouping designated in said designating step includes selected documents commonly classified in a system maintained by the U.S. Patent and Trademark Office (Rivette: column 17, lines 11-20; Note specifically U.S. Patents are the documents classified.).

**Claim 6:**

Rivette discloses all the elements of claim 5, as noted above, and Rivette further discloses wherein the classification system is the classification of goods and services maintained by the U.S. Patent and Trademark Office (Rivette: column 17, lines 55-66).

**Claim 7:**

Rivette discloses all the elements of claim 5, as noted above, and Rivette further discloses wherein said designating step further comprises the step of designating the source grouping as a field of search that includes intellectual property information in the form of patent publications commonly classified in select classes and subclasses, as maintained by the U.S. Patent and Trademark Office (Rivette: Fig. 57, 5718-5722).

**Claim 8:**

Rivette discloses all the elements of claim 2, as noted above, and Rivette further discloses wherein the list of elements generated in said generating step contains a list of words found in the source grouping of intellectual property information (Rivette: Fig. 46, 4608).

**Claim 9:**

Rivette discloses all the elements of claim 2, as noted above, and Rivette further discloses wherein the list of elements generated in said generating step contains a list of concepts found in the source grouping of intellectual property information (Rivette: column 26, lines 29-33; Note specifically concept searching.).

**Claim 10:**

Rivette discloses all the elements of claim 2, as noted above, and Rivette further discloses wherein the list of elements generated in said generating step contains a list of graphical elements found in the source grouping of intellectual property information (Rivette: Fig. 46, 4624).

**Claim 11:**

Rivette discloses all the elements of claim 1, as noted above, and Rivette further discloses a method comprising the steps of:

receiving input data from a user over a network identifying the source intellectual property information for designation in said designating step (Rivette: Fig. 3 and Fig. 116 and Fig. 118; Note specifically client-server and web access.);

outputting from a server the list generated in said generating step to the user over the network (Rivette: Fig. 3 and Fig. 116 and Fig. 118; Again note client-server and web access.).

**Claim 12:**

Rivette discloses all the elements of claim 11, as noted above, and Rivette further discloses a method of comprising the step of:

retrieving the source intellectual property information identified in said receiving step from at least one remote database on the network (Rivette: Fig. 3, 316 and Fig. 4, 316 and Fig. 4, 428).

**Claim 13:**

Rivette discloses all the elements of claim 12, as noted above, and Rivette further discloses wherein the input data received from the user in said receiving step is a list of patent numbers identifying select patents as the source of intellectual property information, and wherein the network is the Internet (Rivette: Fig. 3, 308 and Fig. 140; Note specifically the 'web' and HTTP.).

***Contact Information***

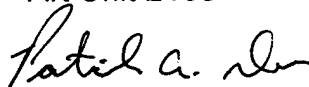
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick A. Darno whose telephone number is (571) 272-0788. The examiner can normally be reached on Monday - Friday, 9:00 am - 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Don Wong can be reached on (571) 272-1834. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

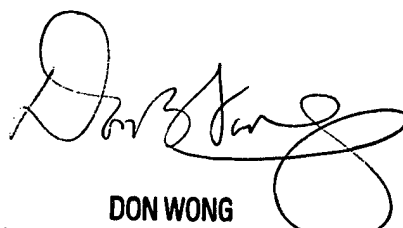
Art Unit: 2163

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Patrick A. Darno  
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